

SN. 10/647,094

ATTORNEY DOCKET NO. FUJI:270

REMARKS

Claims 4, 7-14, 16, and 18-20 remain pending in this application for which applicant seeks reconsideration.

Amendment

Claims 1, 5, 6, and 17 have been canceled. Claim 20 has been amended to define that the underlayer consists essentially of ruthenium based on the examiner's comment that the wherein clause pertaining to the underlayer can include additional elements other than ruthenium. Claims 4, 7, and 8 have been amended to depend from claim 20. Withdrawn method claim 14 has been amended to parallel claim 20. No new matter has been introduced.

Art Rejection

Claims 1, 4-9, 11, and 12 stand rejected under 35 U.S.C. § 102(e) as anticipated by Litvinov (USP 6,656,613). Claims 1, 4-9, and 11 stand rejected under § 102(e) as anticipated by Maesaka (USP 6,596,418). Claims 1, 4-9, and 11-13 stand rejected under § 103(a) as unpatentable over Litvinov. Finally, claims 10 and 20 stand rejected under § 103(a) as unpatentable over Litvinov in view of Hanawa (USPA 2002/0076579). Applicant traverses this rejection.

First, it appears that the examiner inadvertently maintained in the § 102(e) rejections based on each of Litvinov and Maesaka since each of these references would not have disclosed each and every claimed element.

Second, as to the rejection of claim 20, the examiner interpreted that the underlayer can contain other elements beside Ru. Claim 20 has been amended to clarify that the underlayer consists essentially of ruthenium. Litvinov and Hanawa simply would not have disclosed or taught an underlayer consisting essentially of ruthenium formed directly under the magnetic layer. Indeed, Litvinov does not even mention ruthenium in its disclosure. While Hanawa mentions ruthenium, it does so in conjunction with the magnetic layer being composed of multilayer layers, which includes an antiferromagnetic layer 5c formed from ruthenium. Accordingly, applicant submits that Hanawa still would not have taught an underlayer composed of ruthenium since Hanawa's ruthenium layer is part of the magnetic layer.

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Rejoinder of Non-Elected Claims

As non-elected method claim 14 contains all of the elements of claim 20, if claim 1 is allowed, claim 14 **MUST** be rejoined and allowed together. In other words, per the decision in *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), if a method claim contains all of the elements of an allowed apparatus claim, then the method claim is allowable. See also MPEP § 821.04. Moreover, if claim 14 is allowed, then all of the claims depending from it are also allowable.

Conclusion

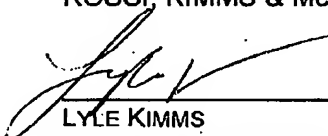
Applicant submits that the pending claims patentably distinguish over the applied references and are in condition for allowance. Should the examiner have any issues concerning this reply or any other outstanding issues remaining in this application, applicant urges the examiner to contact the undersigned to expedite prosecution.

Respectfully submitted,

ROSSI, KIMMS & McDOWELL LLP

12 SEPTEMBER 2005

DATE



LYLE KIMMS

REG. NO. 34,079 (RULE 34, WHERE APPLICABLE)

P.O. Box 826
ASHBURN, VA 20146-0826
703-726-6020 (PHONE)
703-726-6024 (FAX)